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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,440	04/11/2001	Steve Morsa		7403

7590 01/18/2007  
Steve Morsa  
P. O. Box 1996  
Thousand Oaks, CA 91358

EXAMINER
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OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/18/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

09/832,440

Applicant(s)

MORSA, STEVE

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 20 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 181-272 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 182, 185, 204, 207, 226, 229, 248, 251 and 269 is/are allowed.
- 6) ☒ Claim(s) 181, 184, 188-203, 206, 210-225, 228, 232-247, 250, 254-268 and 270-272 is/are rejected.
- 7) ☐ Claim(s) 182, 185, 204, 207, 226, 229, 248 and 251 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 1-180 have been cancelled and Claims 181-272 have been added; therefore, Claims 181-272 are now pending in application 09/832,440.

### ***Specification***

2. The amendment filed 5/22/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention.
3. Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Objections***

4. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Misnumbered claims 252 (duplicate), 253(duplicate), and 254-270 have been renumbered 254-272. Claim 189, 196, and 233 are objected to because of the following informalities: the claims contain spelling and/or punctuation errors. Appropriate correction is required.

6. Claims 182, 204, 226, and 248 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
7. Claims 185, 207, 229, and 251 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **Claim Rejections - 35 USC § 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. **Claims 270-272 are rejected under 35 U.S.C. 102(e) as being anticipated by PMA ("Peter Martin Releases HelpWorks Web Edition," Business Wire, September 28, 1999).**
10. As per **independent Claims 270-272**, PMA discloses a method/system of generating a benefit result list in real or substantially real time (web-based self-service model) in response to a benefit match request from a seeker using a computer network, comprising maintaining at least one database including a plurality of benefit listings (eligibility library / Expert Eligibility Server); receiving a benefit match request from said seeker, said request including

said seekers criteria; identifying those of said benefit listings having criteria which generate a match with said match request; generating automatically a message to inform directly said seeker via said computer network of those of said benefits which match said seekers criteria (Users screen themselves).

### **Claim Rejections - 35 USC § 103**

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**12. Claims 181, 184, 188-203, 206, 210-225, 228, 232-247, 250, and 254-268 are rejected under 35 U.S.C. 103(a) as being unpatentable over PMA ("Peter Martin Releases HelpWorks Web Edition," Business Wire, September 28, 1999).**

13. As per independent Claims 181, 203, 225, and 247, PMA discloses a system [method, computer-readable code, mechanism] for permitting an individual [business, government, educational institutional, or non-profit] to more effectively make use of a variety of available benefits from a plurality of benefit providers (System can be configured to evaluate any or all benefits and programs required - Federal, State and/or Local), wherein said benefits are offered specifically to those individuals eligible to receive said benefits (Purpose of eligibility screening system), said system comprising: means for storing in memory in the system benefit information, benefit provider information, and benefit correlation information

(Expert Eligibility Server, eligibility library); means for analyzing said individuals data, said benefit provider information, and said benefit correlation information to determine whether any benefit providers are offering potentially applicable benefits for said data and whether said data satisfies requirements for obtaining said potentially applicable benefits (Eligibility Screening); means for automatically generating a message to directly inform said individual, at least in part via a computer network, of any benefits applicable to said individuals data (Web enabled self-service module).

14. PMA fails to expressly disclose means for inputting into said system a set of an individual demographic, geographic, and psychographic data for said individual.
15. However, PMA does disclose that the HelpWorks eligibility *screening tool is configurable* to evaluate any or all benefits and or programs required, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the tool to include a multitude of available input criteria to match with the benefit programs in the eligibility library, for the purpose of increasing the system's accuracy in matching results.
16. As per Claims 184, 206, 228, and 250, PMA discloses means for the storage of at least a portion of said individuals data (inherent to internet operations – Expert Eligibility Server).
17. As per Claims 188, 210, 232, and 254, PMA fails to expressly discloses means of requiring said individual to update said individuals data as a condition of said individual continuing to remain a system user.
18. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to require up-to-date information from a user, in order to provide valid

results; and a real-time system would obviously require continual maintenance from users to ensure up-to-date data.

19. As per Claims 189, 211, 233, and 255, PMA fails to expressly disclose means for said individual and or at least one of said benefit providers to pay for said system access and use from at least one from the group of: on a per benefit disclosed basis; on a per benefit received basis; on a per benefit utilized basis; through said individuals relinquishment of at least a portion of at least one of said benefits; through the cash or cash equivalent payment of some part or percentage of the value of at least one of said benefits.
20. However, the article describing the HelpWorks system, does suggest that the system is to be provided by Peter Martin Associates to the public, and Official Notice is taken that charging for services provided to users was a well-known form of business at the time the invention was made. Therefore, it would have been obvious to one of ordinary skill at the time the invention was made to charge for the services provided by PMA.
21. As per Claims 190, 212, 234, and 256, PMA discloses means for receiving directly and or via one or more third party intermediaries of monetary revenue and or other value from at least one benefit provider (PMA Commerce – See rejection of Claims 189, 211, 233, and 255).
22. As per Claims 191, 213, 235, and 257, PMA discloses means for one or more from the group of: updating benefits data; modifying benefits data; removing benefits data; adding new benefits data (user configurable).
23. As per Claims 192, 214, 236, and 258, PMA discloses means for said message to: reveal one or more of said benefits not applicable to individual; provide one or more of said benefit providers not applicable; provide one or more of said benefit providers benefit application

forms; provide one or more of said benefit providers contact information; provide a map for and or direction to one or more of said benefit providers (HelpWorks system is meant to be a screening an *referral* tool).

24. As per Claims 193, 215, 237, and 259, PMA discloses at least one from the group of: *means for connecting said individual with at least one of said plurality of benefit providers*; means for said individual to interact with at least one of said benefits to said individual; means for the completion of one or more application forms, when applicable, by said individual; means for assisting transmitting at least one benefit approval for said individual by at least one of said benefit providers; means for transmitting an acceptance of at least one of said benefits by said individual; means for receiving at least one of said benefits by said individual; means for utilizing at least one of said benefits by said individual (HelpWorks system is meant to be a screening an *referral* tool).
25. As per Claims 194, 216, 238, and 260, PMA discloses means for performing at least one of the listed means for in real or near real time (Web-based system).
26. As per Claims 195, 217, 239, and 261, PMA discloses wherein said individual benefits or benefits information is shared with at least one other entity via said system (Provide user results in caseworker example).
27. As per Claims 196, 218, 240, and 262, PMA discloses wherein said message includes at least one benefit for which said individual: *may qualify for*; and or may not qualify for; and or does qualify for; and or does not qualify for (Pg.1).



28. As per Claims 197, 219, 241, and 263, PMA fails to expressly disclose wherein said message informs individual of at least one benefit contained within said memory without regards to at least some part of said individuals data.
29. However, PMA does disclose that the HelpWorks eligibility *screening tool is configurable* to evaluate any or all benefits and or programs required, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the tool to include benefits that matched all entered criteria as a general baseline or to offer basic results to all users.
30. As per Claims 198, 220, 242, and 264, PMA discloses wherein one or more of said benefit providers submit said benefit information and or said benefits directly into said system (User configurable).
31. As per Claims 199, 221, 243, and 265, PMA discloses wherein at least one of said benefit information and or said benefits from at least one of said benefit providers is delivered directly into said system via at least one third party intermediary acting on behalf of at least one of said benefit providers (PMA configured presets – government benefits).
32. As per Claims 200, 222, 244, and 266, PMA fails to expressly disclose wherein said available benefits vary according to: the amount of said individual's data; and or the completeness of said individual's data.
33. However, PMA does disclose an eligibility-screening tool based on entered criteria, and the amount of criteria entered would obviously equate to varying amounts of system matches (well known function of database correlation systems).

34. As per Claims 201, 223, 245, and 267, PMA fails to expressly disclose wherein at least a partial set of phantom individuals data is inputted; wherein said phantom data does not belong to nor correspond to said individuals actual factual data.
35. However, the phantom data, as claimed above, is simply a user decision to experiment with data inputs to investigate available options, and it would have been obvious to users at the time the invention was made to complete trial and error techniques with the system to investigate the best-fit options available to them.
36. As per Claims 202, 224, 246, and 268, PMA fails to expressly disclose wherein said individuals data includes said individuals identification information.
37. However, PMA does disclose wherein the system can be used as a self-service model; therefore, the user would have to include some sort of identification (e-mail, web-connection ID) in order to receive results from the system.
38. Furthermore, PMA discloses wherein the system is used by caseworkers, who would obviously require a user ID to identify/separate specific case evaluations.

*Allowable Subject Matter*

39. **Claim 269 is allowed**

40. As per Claim 269, the prior art fails to expressly teach or disclose wherein said requester thereafter receives, utilizing said stored request and via a data receiving device, at least one automatically generated updated subset of said benefit information.

41. Claims 182, 185, 204, 207, 226, 229, 248, and 251 are considered allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
42. As per Claims 182, 204, 226, and 248, the prior art fails to expressly teach or suggest means for the display of said benefits to said individual in a manner selected from the group consisting of benefit class or category; value of benefits; cost, if any, of benefits; importance of benefits; relevance of benefits; ease of use of benefits; expiration date, day, time of benefits; creation date, day, time of benefits; types of benefits; physical proximity of said individual to one or more of said benefit providers.
43. Claims 183, 205, 227, and 249 are considered allowable as they depend directly on allowable claims.
44. As per Claims 185, 207, 229, and 251, the prior art fails to expressly teach or suggest means for updating the status and or availability of benefits for said individual as: at least one of said benefit providers intends to or actually does modify the existing benefit qualification parameters for one or more of said providers benefits; and or at least one of said benefit providers intends to or actually does modify or eliminate an existing benefit, or offers one or more benefits not previously offered; and or one or more individual applicable benefits offered by one or more benefit providers new to, or returning to, said system are added to said system.
45. Claims 186, 208, 230, and 252, are considered allowable as they depend directly on allowable claims.

46. Claims 187, 209, 231, and 253 are considered allowable as they depend directly on allowable claims.

*Response to Arguments*

47. Applicant's arguments filed 9/20/06, with respect to Claims 181-272, have been considered but are moot in view of the new ground(s) of rejection and indication of allowable subject matter.

*Conclusion*

48. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
49. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.
50. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

January 16, 2007

JONATHAN OUELLETTE  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3600

